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AF

THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Re: Appeal to the Board of Patent Appeals and Interferences

In re PATENT application of  
FAIRLIE et al.

Group Art Unit: 1743

Application No. 10/829,434

Examiner: Soderquist, Arlen

Filed: April 22, 2004

Docket: 62-337

Title: Energy Distribution Network

Date: March 17, 2008

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

- 1  **NOTICE OF APPEAL:** Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision (not Advisory Action) of the Examiner dated March 12, 2007
- 2  **BRIEF** on appeal in this application attached.
- 3  An **ORAL HEARING** is respectfully requested under Rule 194 (due two months after Examiner's Answer -- unextendable).
- 4  Reply Brief is attached (due two months after Examiner's Answer -- unextendable).

5. FEE CALCULATION:		Large/Small Entity	
If box 1 above is X'd, see box 12 below <u>first</u> and decide: .....		enter	\$510/255*
If box 2 above is X'd, see box 12 below <u>first</u> and decide: .....		enter	\$510/255*
If box 3 above is X'd, see box 12 below <u>first</u> and decide: .....		enter	\$1030/515*
If box 4 above is X'd, .....		enter nothing	- 0 - (no fee)
6. <u>Original</u> due date: March 18, 2008			
7. Petition is hereby made to extend the <u>original</u> due date to cover the date this response is filed for which the requisite fee is attached		(1 mo) (2mos) (3mos) (4mos)	\$120/\$60 \$450/\$225 \$1020/\$510 \$2160/\$1080
8. Enter any previous extension fee paid [ ] previously since above <u>original</u> due date (item 6); [ ] with concurrently filed amendment .....			
9. Subtract line 8 from line 7 and enter: Total Extension Fee			
9a.		Terminal Disclaimer Fee	\$
10.		TOTAL FEE ATTACHED = \$ 0	

11.  \*Fee NOT required if/since paid in prior appeal in which the Board of Patent Appeals and Interferences

did not render a decision on the merits.

CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficient fee only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order No. 50-1130/62-337 for which purpose a duplicate copy of this sheet is attached. This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed.

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Docket No.: 62-337

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of :  
FAIRLIE et al. :  
Serial No.: 10/829,434 : Group Art Unit: 1743  
Filed: April 22, 2004 : Examiner: Soderquist, Arlen  
For: ENERGY DISTRIBUTION NETWORK

**MAIL STOP: APPEAL BRIEF – PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF**

Sir:

Appellants submit this Reply Brief to the Examiner's Answer mailed January 18, 2008, with regard to the Appeal from the rejection of claims 25-27, 29-31, 36, 38-43, 45-61, 63-64, 66 and 82-103 of the above-identified application.

Reply Brief filed March 17, 2008

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## **RESPONSE TO EXAMINER'S ANSWER**

The Examiner maintains the rejection of claims 25-27, 29-31, 36, 38-43, 45-61, 63-64, 66 and 82-103 as being obvious over Pritchard in view of Scragg, Campbell and Takriti.

In the Answer, the Examiner contends that column 2 lines 37-38 of Prichard teach that the “system includes control means to monitor and control the system.” However, in the specification of Prichard, “control means” is mentioned at column 3, lines 39 and relates to the switch, and “means for monitoring” is disclosed at column 4, lines 22-24 and relates to monitoring current density. The Examiner is reminded that although the test for establishing an implicit motivation in the prior art is what a prior art statement would have suggested to those of ordinary skill, such a statement “must be considered *in the context of the teaching of the entire reference.*” *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Thus, Appellants maintain the position that Prichard does not teach a controller in communication with the hydrogen generator and storage for controlling the generation and storage of hydrogen as claimed.

Furthermore, even if it can be interpreted that Prichard discloses a controller to monitor and control the overall system, there is simply no suggestion in Prichard of a controller in communication with the hydrogen generator and storage or a controller that processes data. Campbell, which the Examiner cites as teaching a microprocessor based controller, does not specifically disclose that the microprocessor is in communication with the hydrogen storage 91.

Still further, the Examiner has not shown how Takriti discloses or suggests controlling the generation and storage of hydrogen based on “data pertaining to demand for hydrogen, data pertaining to the availability of electric energy and data pertaining to the status of the hydrogen generator” as claimed. The generic risk/cost factors of Takriti do not include the claimed data. It is well settled that each and every claim limitation must be taught or suggested. As specified in MPEP §2143.03, entitled “**All Claim Limitations Must Be Taught or Suggested**”: “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). ‘All words in a claim must be considered in judging the patentability of that claim against the prior

art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." MPEP §2143.03 at 2100-131 (Rev. 5, Aug. 2006).

With regard to claim 36, the Examiner has failed to show how the prior art of record teaches or suggests each element of the claim.

With regard to claims 40 and 41, Prichard simply fails to teach or suggest controlling the generation and storage of hydrogen when the pressure or amount of hydrogen stored in the storage reservoir falls below a predetermined value or amount. The Examiner's positions appears to be that it is inherent in Prichard to provide the control as claimed in claims 40 and 41. Examiner still has burden to establish that the missing process was necessary in Prichard. See *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993):

"That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448,150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed.Cir.1989).

With regard to claim 43, even if the microprocessor of Campbell can be programmed via some type of interface as the Examiner contends, there is no teaching or suggestion in the prior art of record of a user activation interface for receiving data concerning a demand for hydrogen as claimed.

With regard to claim 45, the Examiner has not shown how each of the elements of the claimed group is taught or suggested by the prior art of record.

For the reasons set forth above and in the Brief, it is clear that Appellant's claims 25-27, 29-31, 36, 38-43, 45-61, 63-64, 66 and 82-103 should be deemed patentable over the references applied. It is respectfully requested that this appeal be granted and that the Examiner's rejections be reversed.

Respectfully submitted,



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**March 17, 2008**

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